

REMARKS

In the February 27, 2006 Office Action, the Examiner noted that claims 1-12 were pending in the application; and rejected claims 1-12 under 35 USC § 103(a). In rejecting the claims, U.S. Patents 5,960,383 to Fleischer, 6,560,620 to Ching; 6,772,165 to O'Carroll (References A-C, respectively in the December 17, 2004 Office Action); and 5,659,742 to Beattie et al. (Reference F in the February 27, 2006 Office Action) and an article by Mani et al. (Reference AK in the Information Disclosure Statement filed June 15, 2001) were cited. Claims 1-12 remain in the case. The rejections are traversed below.

First, it is submitted that the cited portions of the newly cited reference, Beattie et al., added for the rejections of claims 1, 3-7 and 9-12, are irrelevant to the claimed invention. In the first two paragraphs on page 5 of February 27, 2006 Office Action, the "session server" described at column 18, lines 59-63 and illustrated as element 114 in Fig. 1 of Beattie et al. was cited as something "that detects the size of documents" (Office Action, page 5, lines 1-2). Apparently, this was cited because the April 18, 2005 Amendment argued that Fleischer teaches "the document may be divided into lines, sentences, paragraphs, or chapters" (column 4, last line to column 5, line 1) which "are different sizes of units that could be selected, but each of the units used in a particular instance would have just one of these definitions [and thus, there is no 'hierarchy' (claim 1, line 3) in the system taught by Fleischer]" (April 18, 2005 Amendment, page 9, lines 25-27).

The teachings of the cited portion of Beattie et al. do not address what is missing from Fleischer and the rest of the cited prior art, i.e., "recognizing a thematic hierarchy of each of the plurality of documents" (claim 1, lines 3-4). Rather, the cited portion of Beattie et al. only states that the "session server 114 retrieves (from database 118) a size (from field 419) for each document identification number" (column 18, lines 59-61) and "transmits this size information ... to PC 104 where it is displayed as size information 343b" (column 18, lines 63-66). As apparent from Fig. 4A where an example of size information 343b is shown, "this size information" is an amount of storage required for the document, in this case, "14K" which is useless in determining "a thematic hierarchy" of the documents, as recited in claim 1.

In the rejection of claims 1, 3-7 and 9-12, it was acknowledged that Mani et al. and Fleischer (and presumably Ching) did not "teach an apparatus that detects topics of various sizes" (February 27, 2006 Office Action, page 4, last line). However, it is clear from the discussion above that the size information cited in Beattie et al. has nothing to do with "topics" and, more importantly, cannot be used in determining "a thematic hierarchy" as recited in claim 1.

The Examiner may have been misled by the statement in the Amendment filed by Certificate of Mailing on April 18, 2005 (which was received in the U.S. Patent and Trademark Office on April 20, 2005) that "the term 'grading'" is defined in the specification at page 12, lines 16-17 as referring to different 'sizes'" (page 9, last 2 lines). The following sentence provided further clarification, "[a]s indicated by lines 5-7, in claim 1 the different grading or sizes relate the thematic hierarchy that is determined by the apparatus recited in claim 1." Specifically, claim 1 recites, "recognizing a thematic hierarchy of each of the plurality of documents by comprehensively detecting topics of various grading that are included in each of the documents" (claim 1, lines 3-5). Thus, the combination of cited prior art would need to disclose to one of ordinary skill in the art a system that recognizes "a thematic hierarchy" of a set of documents and that this is accomplished by "detecting topics of various grading," i.e., sizes of text, as described, e.g., at page 12, line 16 to page 13, line 5 of the application. The procedure disclosed by Fleischer only recognizes a document element, such as a section or paragraph; there is no suggestion of how to extract a set of successive paragraphs containing various gradings of topics to obtain "a segmentation of a document using similarly graded topics" (claim 1, lines 6-7).

Nothing has been cited or found in any of the cited references even suggesting the features recited in claim 1 that are discussed above. Therefore, it is submitted that claim 1, as well as claims 3-7 which depend therefrom, patentably distinguish over the applied art, for at least the reasons discussed above. Like claim 1, claims 9-12 recite "recognizing a thematic hierarchy of each of the plurality of documents" (claims 9 and 10, line 4; claim 11, line 3; and claim 12, lines 6-7). Therefore, it is submitted that claims 9-12 patentably distinguish over the applied art for at least the reasons discussed above with respect to claim 1.

The rejection of claims 2 and 8 was unchanged from the December 17, 2004 Office Action which relied on Mani et al., Fleischer, Ching and O'Carroll, but not Beattie et al., even though Beattie et al. was used in the rejection of claim 1 from which claims 2 and 8 depend. Nothing was cited in O'Carroll providing the feature allegedly taught by Beattie et al. and acknowledged to be missing from Mani et al. and Fleischer (and presumably Ching). Therefore, it is submitted that claims 2 and 8 patentably distinguish over Mani et al., Fleischer, Ching and O'Carroll which were used in rejecting these claims for the reasons recognized by the Examiner in not rejecting claim 1 over Mani et al., Fleischer and Ching alone. Furthermore, it is submitted that claims 2 and 8 patentably distinguish over the combination of Mani et al., Fleischer, Ching, O'Carroll and Beattie et al. for at least the reasons discussed above with respect to claim 1.

In item 5 on page 3 of the February 27, 2006 Office Action in the Response to Arguments section, it was asserted that the disclosure in Mani et al. of "pinpoint similarities and differences, and align segments' (page 357, Abstract)" (Office Action, page 3, line 8) made it "obvious that the system calculates a relevance score between topics; otherwise it would not extract similarities and differences between topics" (Office Action, page 3, lines 9-10). The Examiner's logic is not understood. While a relevance score could be used in determining similarities and differences between topics, it is possible to extract such information without using relevance scores. A commonly known example is software that compares the differences between the text in two documents, such as the "Track Changes, Compare Documents" feature in Microsoft Word (accessible from "Tools" on the menu in Word 2000). The similarities between the two documents is indicated by unhighlighted text and the differences are indicated by two different types of highlighting (e.g., strikethrough and underlining in the case of patent claims). This does not require calculation of relevance scores. Therefore, it is not understood why the Response to Arguments asserted that the system disclosed by Mani et al. "would not extract similarities and differences between topics" without calculating relevance scores.

For the additional reasons set forth above, it is submitted that claim 2 further patentably distinguishes over the applied art.

Summary

It is submitted that the references cited by the Examiner do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1-12 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Serial No. 09/862,437

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 7/27/06

By: Richard A. Gollhofer
Richard A. Gollhofer
Registration No. 31,106

1201 New York Ave, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501

CERTIFICATE UNDER 37 CFR 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 27, 2006

STAAS & HALSEY
By: John E. Elmer
Date: July 27, 2006